

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-23 are now pending, wherein claim 6 has been amended and claims 21-23 have been added. Specifically, claim 6 has been amended into independent form by including all of the elements of claim 1, from which claim 6 previously depended.

Applicant notes with appreciation the Examiner's acknowledgement of Applicant's claim for foreign priority and that all of the certified copies of the priority document have been received. Applicant also appreciates the Examiner's consideration of the documents cited in the Information Disclosure Statement filed on October 31, 2000.

In the third paragraph of the Office Action the title is objected to as not being descriptive. The title has been amended in a similar manner to that suggested in the Office Action. Accordingly, withdrawal of this rejection is respectfully requested.

In the fourth paragraph of the Office Action claims 1-6 and 8-15 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,999,968 to Tsuda ("Tsuda"). This ground of rejection is respectfully traversed.

Prior to addressing this ground of rejection in detail, a brief description of exemplary embodiments of the disclosed invention are provided to highlight advantageous characteristics thereof. The disclosed invention relates to a network apparatus capable of accessing services provided from a network. Specifically, the network apparatus is provided with improved security for private information in accessing services provided from a network. Conventional Internet terminals display private information obtained from a network, such as the content of a received electronic mail, on a separate display device, such as a telereceiver. Therefore, when the content is retrieved, the user and anyone around the display device can see the content. The display of the retrieved content to others around the display can be undesirable when the retrieved content is private.

To address the above-identified and other deficiencies of conventional systems, the disclosed invention allows a main device to disable an output to a telereceiver coupled to the main device. The main device provides retrieved content to a portable remote controller device which allows users to keep the retrieved content private. In accordance with exemplary embodiments, the retrieved contents can be electronic mail. Accordingly, the main device can store a user name and password for the user, thereby allowing the user to request access to the electronic mail from the portable remote controller device without entering the user name and password.

The main device can provide access to content from a network to a number of portable remote controller devices. In this case, each portable remote controller device is assigned a different identification code. The retrieved content is then provided to particular portable remote controller devices by including the identification code with the retrieved content. Accordingly, the disclosed invention allows users to obtain content from a network and view it privately.

Tsuda does not anticipate Applicant's claim 1, because Tsuda does not disclose all of the elements of Applicant's claim 1. For example, Tsuda does not disclose "a portable remote controller device for remotely controlling said main device by means of communication" as recited in Applicant's claim 1.

M.P.E.P. § 2131.01, citing *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2112 discusses the requirements for a rejection based on inherent disclosure. This section of the M.P.E.P., citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), states that

[t]o establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing being described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities."

Tsuda discloses a system and method for presenting shared information to a network user in a specified order. Specifically, Tsuda discloses a system in which electronic information is automatically converted into a common format and stored by a shared document management unit. The stored documents can be accessed by document access unit 10, also referred to as local machines.

The Office Action asserts that the document access units of Tsuda disclose the portable remote controller device recited in Applicant's claims. Tsuda describes the document access units in column 4-6 and figures 1-2B. However, Tsuda does not mention whether the document access units are portable. Accordingly, there is no express or inherent disclosure in Tsuda of a portable remote controller device as recited in Applicant's claim 1.

Nevertheless, the Office Action cites various portions of column 4 of Tsuda as allegedly disclosing all of the elements of Applicant's claim 1. Although column 4 of Tsuda describes the document access unit 10, there is nothing in column 4 which expressly or inherently discloses that the document access unit 10 is portable.

Because Tsuda does not disclose all of the elements of Applicant's claim 1, Tsuda cannot anticipate Applicant's claim 1. Claims 2-5 and 8-15 variously depend from Applicant's claim 1, and hence, are not anticipated by Tsuda for at least those reasons stated above with regard to Applicant's claim 1.

Tsuda does not anticipate Applicant's claim 6 because Tsuda does not disclose that "said remote controller device further includes display disabling means for, when the information sent from said main device to said display means is not appended with its own identification code, disabling display of the information" as recited in Applicant's claim 6.

To reject Applicant's claim 6 the Office Action asserts that column 7, lines 11-16 of Tsuda discloses a remote controller device which includes a display disabling means. Column 7, lines 11-16 of Tsuda describes the personal

authentication check in step 123 of figure 4. However, as is clear from figure 4, this step is performed by the shared machine and not the local machine (i.e., the document access unit). Because the Office Action is asserting that the local machine of Tsuda discloses the portable remote controller device of Applicant's claims, and because the portion of Tsuda the Office Action relies upon to reject Applicant's claim 6 describes actions performed by the shared machine, the portion of Tsuda cited by the Office Action cannot disclose a remote controller device which includes a display disabling means as recited in Applicant's claim 6. Accordingly, Tsuda cannot anticipate Applicant's claim 6.

For at least those reasons stated above, it is respectfully requested that the rejection of claims 1-6 and 8-15 as allegedly being anticipated by Tsuda be withdrawn.

In the fifth paragraph of the Office Action claims 7 and 16-20 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of the combination of Tsuda and U.S. Patent No. 6,661,784 to Nykänen ("Nykänen"). This ground of rejection is respectfully traversed.

It is respectfully submitted that the rejection of claims 7 and 16-20 is improper because the Office Action has not presented a proper *prima facie* case of obviousness to reject these claims. M.P.E.P. § 2143 sets forth the basic requirements for establishing a *prima facie* case of obviousness. This section states one of the basic criteria for a *prima facie* case of obviousness is that "there must be some suggestion or motivation...to combine reference teachings."

The Office Action relies upon Nykänen as allegedly remedying Tsuda's lack of disclosure of the main device and the remote controller device communicating with each other by means of infrared rays. To support the combination of Tsuda and Nykänen, the Office Action cites column 4, lines 56-62 of Tsuda and asserts that one of ordinary skill in the art would have been

motivated because of reduced data transmission cost and small transmission output power requirements.

In column 4, lines 28-31 Nykänen describes that it is preferable to use piconets because there is no charge associated with such communications as compared to communications using a mobile communications network. Accordingly, the reduced transmission costs discussed in column 4, lines 56-62 of Nykänen are reduced relative to the costs of using a mobile communications network. However, Tsuda does not disclose or suggest that the document access unit communicates with the shared machine over a wireless connection. Accordingly, it appears that Tsuda does not have the problems which would be resolved by the reduced costs of using a piconet compared to a mobile communications network and the small transmission power of piconets disclosed by Nykänen. Therefore, the motivation provided by the Office Action would not in fact have motivated one of ordinary skill in the art to combine Tsuda and Nykänen in the manner described in the Office Action.

Because the motivation provided by the Office Action would not have motivated one of ordinary skill in the art, the Office Action has not provided "some suggestion or motivation...to combine reference teachings" as is required to establish a *prima facie* case of obviousness. Therefore, the rejection of claims 7 and 16-20 is improper and should be withdrawn.

New claims 21-23 are patentably distinguishable over the documents of record for at least the reason that these documents do not disclose or suggest the step of "disabling the output to the display device when it is determined that the output is not allowed."

All outstanding objections and rejections having been addressed, it is respectfully submitted that the present application is in immediate condition

for allowance. Notice to this effect is earnestly solicited. If there are any questions regarding this response or the application in general, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 038849.49341US).

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Respectfully submitted,



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